

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 09/944,993
Filing Date: August 30, 2001
Title: BIT INVERSION IN MEMORY DEVICES

Page 11
Dkt: 703.155US1

REMARKS

This responds to the Office Action mailed on January 14, 2005.

Claims 1, 7, 11, 13, 15-17, 21, 25, 28, 33, and 40 are amended; as a result, claims 1-46 are now pending in this application. The claim amendments do not introduce any new matter. Furthermore, the amendments are made to place the present application in condition for allowance. Additionally, Applicant does not believe that the amendments necessitate a new search. Therefore, Applicant respectfully requests that the amendments be entered.

§101 Rejection of the Claims

Claims 13-16 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. The Examiner asserts that Claim 13 fails to positively recite function which can be realized in a computer system. As a result of this interpretation, the Examiner asserts that claim 13 is directed to non-statutory subject matter and therefore rejected.

Although the Applicant disagrees with the Examiner's interpretation of the language of claim 13, claim 13 has been amended to now positively recite that the inversion bit is "set by a data source"; thereby "a state within the data source is changed permitting the data stream to be inverted when transferred from the data source to a target source." Applicant asserts that this amendment now clearly recites a change in state in a device, namely the data source. Applicant further asserts that the change in state in a device is statutory as defined by the MPEP and the case law. Accordingly, Applicant believes that this rejection is no longer appropriate and should be withdrawn.

§112 Rejection of the Claims

Claims 13-16 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has objected to the "may be" language in claim 13 as being indefinite. Applicant traverses. However to move the application toward allowance, applicant amends claim 13 to clarify and possibly not narrow the claim language. Therefore, applicant requests that this rejection be withdrawn.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
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Title: BIT INVERSION IN MEMORY DEVICES

Page 12
Dkt 703.155US1

§102 Rejection of the Claims

Claims 1-5, 7-9, 13-18, 21, 23, and 25-27 were rejected under 35 USC § 102(e) as being anticipated by de la Iglesia et al. (U.S. 6,490,703). It is of course fundamental that in order to sustain an anticipation rejection that each and every step or element in the rejected claim must be taught or suggested in the cited reference. Here, de la Iglesia fails to teach bit inversion that occurs “on or within a data source” as is now positively recited and claimed in amended independent claims 1, 7, 13, 17, 21, and 25.

More specifically, the Examiner has asserted that the data source in the de la Iglesia reference is the application supplying data and that the storage is the memory. This is relied upon by the Examiner in each of the rejections of the claims listed above. However, Applicant’s amended independent claims now positively recite that the operation and elements used to invert a data stream and to set an inversion bit are included within or on a data source. This cannot be the case in de la Iglesia, because the bit inversion is handled a separate interface, which is independent of the applications. Thus, the Applicant respectfully asserts that de la Iglesia cannot be said to anticipate the above-mentioned independent claims and that the current rejections should be withdrawn.

Claims 1-7, 8-12, 19-22, 24-26, 28-37, 39-41, and 44-46 were rejected under 35 USC § 102(b) as being anticipated by Norman (U.S. 5,873,112). Again, to sustain an anticipation rejection each and every step and element of the rejected claims must be taught or suggested in the cited reference. Similar to de la Iglesia, the Norman reference lacks a teaching or suggestion of a teaching where the processing or elements associated with bit inversion occur “on or within a data source.”

As one example, the Examiner cites that the data source device of Norman is element 401 in FIG. 7 of Norman and that the storage is 416 and the controller is 429. These are listed as separate elements and components in Norman. Conversely, and as one example, amended independent claim 40 indicates that the data source includes controllers and the storage. In Norman, the data source is not the same device or component that performs the inversion or inversion analysis. Accordingly, the rejections with respect to Norman should be withdrawn.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
Serial Number: 09/944,993
Filing Date: August 30, 2001
Title: BIT INVERSION IN MEMORY DEVICES

Page 13
Dkt: 703.155US1

because it fails to teach each and every element and step in Applicant's amended independent claims 1, 7, 11, 17, 21, 25, 28, 33, and 40.

§103 Rejection of the Claims

Claims 38, 42, and 43 were rejected under 35 USC § 103(a) as being unpatentable over Norman in view of Goldstein (U.S. 2003/0028672). Claim 38 is dependent from amended independent claim 33 and claims 42-43 are dependent from amended independent claim 40. Thus, for the amendments and remarks presented above with respect to independent claims 33 and 40, the rejections with respect to claims 38 and 42-43 should be withdrawn.

Reservation of the Right to Swear Behind References

Applicant maintains its right to swear behind any documents which are cited in a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited documents are not to be interpreted as admissions that the documents are prior art.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 - EXPEDITED PROCEDURE

Serial Number: 09/944,993

Filing Date: August 30, 2001

Title: BIT INVERSION IN MEMORY DEVICES

Page 14

Dkt: 703.155US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney Joseph P. Mehrle at 513-942-0224, or the below-signed attorney at (612) 349-9587, to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

13 April '05

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as via facsimile to 703-872-9306, addressed to: Attn: Examiner Woo H. Choi, Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of April, 2005.

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Name

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Signature